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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,314	03/22/2004	Mark Stanley Tenney	MST032204	2533
7590 Mr. Mark S. Tenney 4313 Lawrence Street Alexandria, VA 22309		07/07/2009	EXAMINER RANKINS, WILLIAM E	
			ART UNIT 3696	PAPER NUMBER
			MAIL DATE 07/07/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/805,314

**Applicant(s)**

TENNEY, MARK STANLEY

**Examiner**

WILLIAM E. RANKINS

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 March 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.  
4a) Of the above claim(s) 10-16 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 17-24 is/are rejected.  
7) ☒ Claim(s) 1-9 and 17-24 is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 06/22/2004 was filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Status of Claims***

Claims 1-24 are pending in this application. Claims 10-16 are canceled and claims 1, 3, 4, 5, 9 and 11 are amended. Claims 17-24 are new.

### ***Response to Arguments***

1. Applicant's arguments, see pgs. 29-34, filed 03/30/2009, with respect to the objection to the specification have been fully considered and are persuasive. The objection of 10/26/2007 has been withdrawn.
2. Applicant's arguments, see pgs. 37-38, filed 03/30/2009, with respect to the numbering of claims 1-16 have been fully considered and are persuasive. The claim objection of 10/26/2007 has been withdrawn.

3. Applicant's arguments, see pg. 40, filed 03/30/2009, with respect to claim 3, 9, 11, 13 and 14 informalities have been fully considered and are persuasive. The claim objection of 10/26/2007 has been withdrawn.
4. Applicant's arguments, see pgs. 40-43, filed 03/30/2009, with respect to improper dependent form of claims 4, 5, and 10, 11 and 12 have been fully considered and are persuasive. The claim objection of 10/26/2007 has been withdrawn.
5. Applicant's arguments, see pg. 44, filed 03/30/2009, with respect to the description of claims 1-16 have been fully considered and are persuasive. The claim objection of 10/26/2007 has been withdrawn.
6. Applicant's arguments, see pg. 45, filed 03/30/2009, with respect to claims 10-16 have been fully considered and are persuasive. The 101 rejection of 10/26/2007 has been withdrawn.
7. Applicant's arguments filed 03/30/2009 have been fully considered but they are not persuasive. With regard to the 101 rejection of claims 1-9 the examiner rejected these claims due to lack of patentable utility. With regard to the method claims, the Court of Appeals for the Federal Circuit recently decided in *In re Bilski* that a method claim must meet a specialized, limited meaning to qualify as a patent eligible process claim. The test for a method claim is whether the claimed method is (1) tied to a

particular machine or apparatus, or (2) transforms a particular article to a different state or thing. In the present case the reference to a computer in claim 1 is similar to a reference in the preamble to another statutory class. Without a sufficient tie in the body of the claim to the machine or apparatus in the preamble the claim is not considered a patent eligible process because the machine or apparatus must impose meaningful limits on the claims scope. In the present case, the extent to which the computer is used is not defined, therefore a meaningful limit on the scope of the claim cannot be assessed. Additionally, according to MPEP 2107, a claimed invention must have a specific and substantial utility as asserted by the disclosure of the invention. In the present case, claim 1 is directed toward the simulation of variables using a particular process. Based on the disclosure it cannot be determined what is the specific utility of these variables and if the utility is substantial if there is one. A practical utility is a shorthand way of attributing real world value to claimed subject matter. In other words, one skilled in the art can use a claimed discovery in a manner which provides some immediate benefit to the public (MPEP 2107.01).

8. Applicant's arguments, see pgs. 48-49, filed 03/30/2009, with respect to claims 10-16 have been fully considered and are persuasive. The 101 rejection of claims 10-16 has been withdrawn.

9. Applicant's arguments, see pgs. 51-52, filed 03/30/2009, with respect to claims 1-16 have been fully considered and are persuasive. The objection of claims 10-16 has been withdrawn.

A review of the claims and updated search necessitated the rejections below.

### ***Claim Objections***

1. Claim 1, 8, 18 and 20 are objected to because of the following informalities: The independent claims do not follow suggested USPTO format. See 37CFR 1.75(e).

Appropriate correction is required.

2. Claims 3, 5 and 9 are objected to because of the following informalities: As stated previously, the guidelines for making claim amendments should be followed. Any words deleted should be shown as striked out and any words added should be shown as underlined. If striking out or underlining of words is too extensive or complicated a claim can be canceled and rewritten as new. Appropriate correction is required.

3. Claim 2 is objected to as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "the RS-VAR" in line 2. There is insufficient antecedent basis for this limitation in the claim. The preceding claim references an essential RS-VAR. The

specification makes a distinction between an RS-VAR and an Essential RS-VAR.

Therefore the reference to the RS-VAR suffers from a lack of antecedent basis.

4. Claims 1-9 and 17-24 are objected to as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present case the claims do not delineate the steps required to simulate GFV variables using an essential RS-VAR. The examiner is forced to discern how this is done by referencing the specification, however, the examiner is precluded from importing limitations from the specification into the claims. As a result a reasonable search and complete examination by the examiner is not possible.

***Note***

The examiner strongly suggests that the applicant retain a qualified patent attorney or agent or at the least consult available literature on claim construction and patent prosecution. It is in the applicant's best interest to obtain the best and broadest protection available through proper claim construction and disclosure of the invention.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 18-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In the present case, neither a portfolio nor a financial product are considered statutory subject matter. MPEP 2106, IV. B states:

The burden is on the USPTO to set forth a prima facie case of unpatentability. Therefore if USPTO personnel determine that it is more likely than not that the claimed subject matter falls outside all of the statutory categories, they must provide an explanation. For example, a claim reciting only a musical composition, literary work, compilation of data, >signal,< or legal document (e.g., an insurance policy) per se does not appear to be a process, machine, manufacture, or composition of matter.



***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William E. Rankins whose telephone number is 571-270-3465. The examiner can normally be reached on M-F 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William E Rankins/

Examiner, Art Unit 3696

06/25/2009

/THOMAS A DIXON/

Supervisory Patent Examiner, Art Unit 3696